APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/749,323	CHECKOWAY ET AL.
	Examiner	Art Unit	
	Arrienne M. Lezak	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *8/27/2001*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 9 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

extensive consideration of US Patent US 6,438,539 B1 to Korolev in view of US Patent

5,826,269 to Hussey.

3.   An information system, method and agent accessible over a computer data

network, comprising:

-    a user e-mail client able to send and receive e-mail messages, (Col. 4,

     lines 47-57);

-    an e-mail server able to send and receive e-mail messages, (Col. 4, lines

     47-57);

-    a computer data network intermediate to the user e-mail client

     and the e-mail server, (Col. 4, lines 47-57);

-    a receiver, (answering-agent), for accepting e-mail messages over the

     computer data network, (Col. 5, lines 23-31);

-    a topic, (in the form of "topic@ recipient.com"), and a qualifier/constraint,

     (preceded by "Subject:"), disposed in said e-mail messages that represent

     a reference information query, (Col. 10, lines 43-57; Col. 11, lines 13-67;

Col 12; and Col. 13, lines 1-35), (Examiner notes that Korolev discloses

meta searching and keyword searching by keyword strings, (in addition to

mention of a plurality of search strategies generally – Col. 3, line 61),

which search methods obviously anticipate Applicants specific method of

enumerating a search through an email. Further, Examiner notes that

Korolev also discloses the use of email – Col. 5, line 35 & Col. 6, lines 16

– the use of an email message for query submission and response receipt

would have been obvious to one of ordinary skill in the art at the time of

invention by Applicant, as the same is an obvious and necessary form of

filtering and queuing within a system receiving multiple queries and

providing multiple responses);

-       a database for storing said topic and qualifier together with a

return address of the user e-mail client, (Col. 5, lines 3-4; Col. 7, lines 50-

67; Col. 8, lines 1-3; and Col. 10, lines 22-57) ;

-       a scheduler for invoking previously scheduled, stored requests, (Col. 9,

lines 5-67 & Col. 10, lines 1-7);

-       a plurality of topic servers for researching information that can be used in

said response, and that are selected according to said topic and filtered by

said qualifier, (Col. 5, lines 10-67 & Col. 6, lines 1-52);

-       an action/transaction method providing a mechanism whereby email

messages containing answers from one answering-agent can be replied-

to or forwarded to another answering-agent to obtain additional

information or to invoke other processes, (Col. 5, lines 10-46); and

-       a composer for constructing a responsive e-mail message with

information provided by one of the plurality of topic servers and that is sent

to said return address, via a mail server on the Internet to a recipient

corresponding to one referenced in said topic@recipient.com, (Abstract &

Col. 6, lines 43-44), (Examiner notes that Korolev teaches the use of email

messages, database-stored user email addresses and submission of

search results to the user, the combination of which anticipates Applicant's

specific method of returning information to referenced recipient).

4.   Though Korolev discloses a requester search agent, (Col. 3, lines 8-37) and the

use of email, (Col. 6, line 16), Korolev does not specifically indicate that requests are

made through the email. Hussey discloses an electronic mail interface for a network

server, (Abstract; Col. 3, lines 39-67; and Col. 4, lines 1-16). To use an email request

within the Korolev method would have been obvious to one of ordinary skill in the art at

the time of invention by Applicant as within a network environment it would be beneficial

for a client, (post-request), to be able to disconnect from the server, retrieving the

results at another time, (Col. 2, lines 36-42). Thus, Claims 1, 9 & 10 are found to be

unpatentable over considerable consideration of Korolev in view of Hussey.

5.   Regarding Claims 2, 11 & 12, Korolev in view of Hussey is relied upon for those

teachings disclosed herein. Korolev further discloses an information system, method

and agent accessible over a computer data network further comprising: an ad server

connected to the composer and able to inject advertisements for which a fee has been paid, (per pending Claims 2 & 11), and wherein an advertisement is not inserted in a particular one of said outgoing e-mail answers if it is addressed to a user who has paid a subscription fee, (per pending Claim 12), (Col. 4, lines 5-7 & Col. 6, lines 7-26) (Examiner notes that Korolev teaches the use of multimedia search criteria as well as an advertising/publishing/posting functionality responsive to all potential requestors, the combination of which renders Applicants fee-based advertisement inclusion obvious.) Thus, Claims 2, 11 & 12 are found to be unpatentable over considerable consideration of Korolev in view of Hussey.

6.   Regarding Claim 3, Korolev in view of Hussey is relied upon for those teachings disclosed herein. Korolev further discloses an information system, method and agent accessible over a computer data network wherein each one of the plurality of topic servers is specialized and researches a single topic area, (Col. 2, lines 21-67; Col. 3; Col. 4, lines 1-12; Col. 5, lines 1-46; and Col. 12, lines 37-40), (Examiner notes that in populating the internal database(s) by specific interest area, Korolev obviously anticipates Applicant's specialized topic server(s)). Thus, Claim 3 is found to be unpatentable over considerable consideration of Korolev in view of Hussey.

7.   Regarding Claims 4 & 5, Korolev in view of Hussey is relied upon for those teachings disclosed herein. Korolev further discloses an information system, method and agent accessible over a computer data network wherein a webserver connected to the plurality of topic servers and the database, and having a HTTP connection to the Internet, wherein, said topics and qualifiers can be delivered over the Internet from a

client browser (or a wireless client using WAP – per pending Claim 5), and said

responses are composed as HTTP documents, (Col. 5, lines 40-46; Col. 11, lines 59-

67; and Col. 12, lines 1-40), (Examiner notes that web pages are http documents).

Thus, Claims 4 & 5 are found to be unpatentable over considerable consideration of

Korolev in view of Hussey.

8.   Regarding Claim 6, Korolev in view of Hussey is relied upon for those teachings

disclosed herein. Korolev further discloses an information system, method and agent

accessible over a computer data network wherein the composer selectively responds

with either a plain text answer or an HTTP document that includes clickable hypertext

that links to further information on said topic that can be browsed by a user, (Col. 11,

lines 59-67; and Col. 12, lines 1-40), (Examiner notes that Korolev teaches the return of

web pages, which pages would obviously include both plain text and clickable hypertext

to further information to be browsed by user). Thus, Claim 6 is found to be

unpatentable over considerable consideration of Korolev in view of Hussey.

9.   Regarding Claims 7 & 8, Korolev in view of Hussey is relied upon for those

teachings disclosed herein. Korolev further discloses an information system, method

and agent accessible over a computer data network wherein a qualifier is remembered

for each said user and is used as a default qualifier when a current query lacks a

qualifier, (per pending Claim 7), (Col. 9, lines 5-67; Col. 10; and Col. 11, lines 1-12) and

wherein qualifier represents a physical location of said user and responses to said topic

are filtered according such physical location, (per pending Claim 8), (Col. 10, lines 22-

42), (Examiner notes that the storage of customer activity and system transaction

obviously includes qualifiers, which qualifiers would obviously be available for default use. Further, as user information includes address information, and Korolev teaches filtering of responses, it would have been obvious to filter responses by user address/physical location). Thus, Claims 7 & 8 are found to be unpatentable over considerable consideration of Korolev in view of Hussey.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (703)-305-0717. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703)-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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